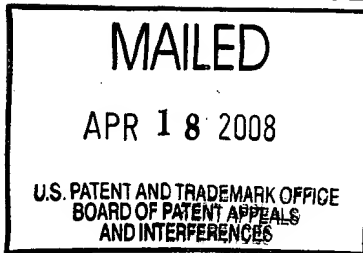


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TOSHIAKI OKUNO  
and  
MASAYUKI NISHIMURA

---

Application 09/781,564

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on April 10, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An Appeal Brief was filed January 29, 2007, in response to the Notice of Defective Appeal Brief mailed January 24, 2007.

It is noted that while the “Summary of Claimed Subject Matter” appearing on pages 2-6 of the Appeal Brief filed January 29, 2007 refers to the various independent claims by reference to the drawings, it fails to map the elements of the independent claims to the specification by page and line number as required by 37 CFR § 41.37(c)(1)(v).

37 CFR § 41.37(c)(1)(v) (2006) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

It is unnecessary for Appellant to file an entirely new Appeal Brief; rather, Appellant may file a “paper” correcting the required appendix.

ACKNOWLEDGMENT OF REPLY BRIEF

A Reply Brief was filed on January 16, 2007, in response to the Examiner's Answer mailed November 14, 2006. However, there is no evidence of record that the Examiner considered or acknowledged the Reply Brief. Section 41.43 of the CFR states:

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

Consideration and acknowledgment of the Reply Brief is required.

CONCLUSION

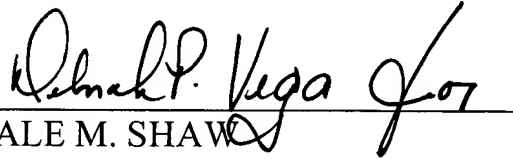
Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed January 29, 2007, defective;
- 2) notify Appellants to submit a "paper" which corrects the "Summary of Claimed Subject Matter";
- 3) for consideration and acknowledgment by the Examiner of any "paper";

- 4) for consideration and acknowledgment of the Reply Brief filed  
January 16, 2007; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:   
DALE M. SHAW  
Chief Appeals Administrator  
(571) 272-9797

DMS:psb

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